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Date:

8/22/06

By:

Patti Hespell
Patti HespellMAIL STOP AFIN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re: Patent Application of Charles A. Eldering.

Conf. No.: 7576 : Group Art Unit: 2623
Appln. No.: 10/068,771 : Examiner: Huynh, Son P.
Filing Date: 05 February 2002 : Attorney Docket No.: T742-10
Title: Targeted Advertising in On-Demand Programming

Request for Pre-Appeal Brief Conference

Applicant(s) request(s) review of the final rejection in the above-identified application, under the Pre-Appeal Brief Conference Program published on July 12, 2005. No amendments are being filed with this request.

- ☒ The review is requested for the reason(s) stated on the attached sheet(s).
☒ Notice of Appeal from the Examiner to the Board of Patent Appeals and Interferences is filed herewith.

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STATEMENT IN SUPPORT OF REQUEST FOR PRE-APPEAL BRIEF CONFERENCE

Presently, claims 194, 197-200, 202, and 213-233 are pending in the application. This paper is being filed in support of the Request for Pre-Appeal Brief Conference submitted herewith. Details of the Examiner's rejections may be found in the Final Office Action dated February 24, 2006 ("Final Office Action") and the Examiner's Advisory Action dated July 31, 2006 ("Advisory Action"). Discussion of the prior art references and the pending claims may be found in Applicant's Amendment filed November 21, 2005 ("Amendment") and Applicant's Response After Final Rejection filed June 26, 2006 ("Response After Final"), both of which are incorporated herein by reference.

No Prima Facie Case of Obviousness

Even though the Examiner has not established a *prima facie* case for obviousness, the Examiner has not withdrawn the rejection of claims 194, 197-200, 202, and 213-233 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,463,585 B1 to Hendricks *et al.* ("Hendricks") in view of U.S. Patent No. 6,909,837 to Unger ("Unger"), and further in view of U.S. Patent Publication No. 2002/0129362 to Chang *et al.* ("Chang").

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art references, when combined, must teach or suggest all of the claim limitations. See MPEP 2143.

1. No Motivation to Combine the References

The Examiner can satisfy the burden of *prima facie* obviousness only by showing an objective teaching in the prior art, or that knowledge generally available to one of ordinary skill in the art, would lead that individual to combine the relevant teachings of the references in the manner suggested by the Examiner. See *In re Fine*, 5 USPQ2d 1596, 1598 (Fed. Cir. 1998). The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not the applicant's disclosure. See *In re Vaeck*, 947 F.2d 488,

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20 USPQ2d 1438 (Fed. Cir. 1991). The mere fact that the prior art could be modified in the manner proposed by the Examiner, does not make the modification obvious unless the prior art suggests the desirability of the modification. *See Ex Parte Dussaud*, 7 USPQ2d 1818, 1820 (Bd.Pat.App & Interf. 1988).

The Examiner has failed to point to a convincing motivation that would lead one skilled in the art to combine Hendricks, Unger, and Chang. More specifically, the Examiner has oversimplified the teachings of the references themselves in order to give the fallacious appearance that there is an objective teaching in the references that would lead to their combination. As previously discussed in Applicant's Response After Final, there is no express or implied suggestion within the references to combine the references (Response After Final, pages 5-6). In the Advisory Action, the Examiner argues that Hendricks "discloses displaying an alternative advertisement," that Unger discloses "displaying alternative advertisement," and that therefore there is a valid motivation to combine the references.

First, although independent claim 194 uses the term "alternative advertisement," a valid motivation to combine is not established simply because the references use the word "alternative" in close proximity to the word "advertisement." For that matter, a motivation to combine is not established simply because those references happen to include portions of the claim language. Furthermore, the advertisements provided via feeder channels in Hendricks (labeled alternative advertisement by the Examiner) are significantly different from the condensed advertisements (also labeled alternative advertisements by the Examiner) taught by Unger. Thus, despite the similarity of words, there is no similarity between the advertisements taught by each reference. Moreover, the Examiner does not point to any teaching that suggests why one skilled in the art would desire to modify the teachings of Hendricks to minimize the interruption of commercials, when, in contrast to shortened commercials, Hendricks teaches providing full length targeted commercials that are presented in their entirety. This is simply not a convincing line of reasoning that warrants the Examiner's conclusory statement that it would be obvious to combine the Hendricks and Unger.

The Examiner employs a similarly spurious line of reasoning in arguing that Chang is combinable with the defective combination of Hendricks and Unger. Although the concept of the alternative commercial taught by Chang is significantly different than the advertisements provided

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via feeder channels in Hendricks and the condensed advertisements taught by Unger, the Examiner again finds mention of the word "alternative" in close proximity to the word "advertisement" to be sufficient motivation to combine. The Examiner also contends that this combination improves convenience to users (Advisory Action, page 2). Such reason is insufficient, since virtually every invention can be said to be directed towards improving the convenience of users (Response After Final, pages 5-6).

Furthermore, there is good reason why an individual with knowledge of Hendricks and Chang would not look to Unger to modify either of these references. The Examiner has ignored that Hendricks and Chang function in the context of a television delivery network, whereas Unger addresses video recordings. Contrary to the Examiner's contention, those skilled in the art of Unger (e.g., manufacturers of video recording equipment) would have little interest in the "broadcaster's source of revenue," and in fact are commonly at odds with broadcasters. Furthermore, Chang teaches a method to heighten interest in commercials, while Unger teaches a method to allow users to fast forward through commercials. Clearly, fast forwarding through a commercial does not show or allow for a heightened level of interest (Response After Final, pages 5-6). Accordingly, Applicant maintains that the Examiner has pointed to, nor is there, an objective teaching to combine the references.

2. The Proposed Combination Changes the Principle of Operation of the Primary Reference

If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. See *In re Ratti*, 270 F.2d 810, 123 U.S.P.Q. 349 (C.C.P.A. 1959); MPEP § 2143.01.

The combination of Unger with Hendricks would change the principle of operation of Hendricks. Hendricks functions by packing targeted programming into different categories, and then switching to feeder channels to provide targeted advertisements accordingly. Hendricks determines "how many feeder channels will be needed for each programming break of all programs airing at the same time" (Hendricks, column 30 lines 54-57). In Unger, the presentation of programs and advertisements are time-shifted. If a program is time shifted by recording and

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playing it at a later time as in Unger, it would be impossible to determine how many of Hendricks' feeder channels would be needed at a certain time. Thus, Hendricks' entire concept of targeting using categories and feeder channels would cease to exist. Moreover, Hendricks relies on the alignment of program breaks across all the program channels for management of the feeder channels for the targeting of ads. Thus, if the time shifting features of Unger are combined with Hendricks there would no longer be any alignment of programs or program breaks. As such, incorporation of Unger's system (i.e., the play back of recorded video) would render the feeder channels and other time-dependent functions of Hendricks inoperative.

Furthermore, it appears that the Examiner's proposed combination requires the modification of Unger with the teachings of Chang. Although the Examiner's basis for combining the three references is unclear at best, Applicants submit that any combination of Chang with Unger would also render Unger's system inoperable (Response After Final, page 6).

3. The Proposed Combination does not Teach or Suggest All Aspects of the Claims

The proposed combination of Hendricks, Unger, and Chang fails to teach or suggest displaying "an alternative advertisement as a partial screen display in conjunction with the fast-forwarded or skipped advertisement, wherein the alternative advertisement and the fast-forwarded or skipped targeted advertisement are simultaneously presented to the subscriber...," as recited in independent claim 194.

In maintaining the final rejection, the Examiner argues that the "'alternative advertisement and the fast-forwarded or skipped targeted advertisement are simultaneously presented' is broadly read on displaying the tagged frame/condensed version of the advertisement that contains portion/content of both the alternative advertisement and the advertisement being fast-forwarded on the screen" (Advisory Action, page 2). Contrary to the Examiner's contention, Unger teaches that an alternative ad or static image "replaces" the fast forwarded ad, (Response After Final, pages 3-4 and Unger, column 7, lines 20-22). Thus, Unger's teachings do not lead to a conclusion that two advertisements are simultaneously displayed. Moreover, displaying the I-frames of an ad is simply not the same as displaying the fast-forwarded ad or even a portion of the fast-forwarded ad. Unger itself describes displaying fast-forwarded video as increasing "the rate at which the frames

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of the video signal...are retrieved and passed to the television..." (Unger, column 5, lines 11-15). Thus, Unger's teachings directly refute the Examiner's contention that the display of individual I-frames is the same as displaying fast-forwarded video. Thus, displaying I-frames is not "presenting...the fast forwarded or skipped advertisement" as recited in claim 194. Furthermore, if, as suggested by the Examiner, Unger's display of I-frames is considered to be both the fast-forwarded ad and the alternative ad, then to satisfy independent claim 194, the I-frames would have to be displayed in one portion of the partial screen display, as well as the other portion of the partial screen display. This illogical reading of Unger would result in the *same shortened video clip* being displayed in *each portion* of the partial screen display. Such a result is different than independent claim 194, which recites, presenting "an alternative advertisement as a partial screen display in conjunction with the fast-forwarded or skipped advertisement, wherein the alternative advertisement and the fast-forwarded or skipped targeted advertisement are simultaneously presented to the subscriber..." Thus, the Examiner's contention that Unger teaches the simultaneous display of an alternative advertisement and a fast-forwarded advertisement is incorrect. Accordingly, the proposed combination does not teach or suggest all of the features of claim 194 (Response After Final, pages 3-5).

Applicant respectfully submits that the combination of Hendricks, Unger and Chang is thus improper since the Examiner has not pointed to an objective teaching which suggests the motivation to combine them. Furthermore, such a proposed combination would render at least the primary reference inoperable. Even assuming the references were properly combinable, which they are not, all features of the claims would still not be taught by the combination. Therefore, the Examiner has not met the burden of establishing a *prima facie* case for obviousness. Accordingly, for the reasons detailed herein as well as in Applicant's Amendment and Response After Final, independent claim 194, independent claim 202, and all claims dependent thereon, are allowable over Hendricks in view of Unger and in further view of Chang.

Applicant respectfully submits that the Examiner's rejections have been previously overcome, and that the application, including claims 194, 197-200, 202, and 213-233, is in condition for allowance. Reconsideration and withdrawal of the Examiner's rejections and a Notice of Allowance are respectfully requested.